II. REMARKS/ARGUMENTS

These Remarks are in response to the Office Action mailed March 17, 2006. No fee is believed due for the addition of any new claims.

Claims 1, 4, 8, and 10-20 were pending in the Application prior to the outstanding Office Action. The Office Action rejected claims 1, 4, 8, and 10-20. Claims 1 and 15 have been amended. Claims 21-25 have been added. Claims 1, 4, 8, and 10-25 remain pending in the Application.

Claims 1 and 15 have been amended to recite the language of originally amended claim 1, filed on December 8, 2004. Claims 21-25 correspond with original claims 2, 3, 5, 7 and 9. Because the Stifelman reference is not prior art, Claims 1, 15 and 21-25 as currently presented are believed not to be subject to prosecution history estoppel.

ACTUAL REDUCTION TO PRACTICE PRIOR TO STIFELMAN

The Examiner found the previous Declaration of Inventors supported by Exhibits 'A'-'C' did not establish actual reduction to practice of the invention prior to the effective date of the Stifelman reference. The Applicant herein supplies the current declaration of Drs. Patrick Chiu, Donald G. Kimber, John Steven Boreczky and Andreas Girgensohn signed by all inventors and supported by Exhibits 'A'-'C' and Exhibit 'D'. Exhibit 'D' is a redacted version of the original FXPAL invention disclosure form signed between March 9, 2000 and March 14, 2000 by all the inventors and witnessed by Ms. Eleanor Reiffel an employee of Fuji Xerox Palo Alto Laboratories. The Applicant believes that the declaration together with these exhibits show actual reduction to practice of the claimed invention prior to the publication date of the Stifelman reference (March 31, 2001).

Specifically, Exhibit 'D' discloses a method for creating multimedia meeting minutes (see Exhibit 'D', p. 3, 5th paragraph, 2nd sentence) where (a) a user takes notes (see Exhibit 'D', p. 3, 5th paragraph, 5th sentence) and the notes are sent to a server (see Exhibit 'D', p. 3, 6th paragraph, 1st sentence) and are available to any meeting participant (see Exhibit 'D', p. 5, 1st paragraph, 1st sentence); (b) automatically recording an index value for the notation, the index value based on the context of the notation (see Exhibit 'D', p. 5, 5th paragraph, 3rd sentence); (c) receiving a quantity of multimedia information from at least one multimedia

source (see p. Exhibit 'D', 3, 5th paragraph, 7th sentence); (d) automatically selecting at least one portion of the quantity of the multimedia information based on the index value of the notation (see Exhibit 'D', p. 3, 6th paragraph, 2nd sentence); (e) automatically creating an association between the notation and the selected portion of the quantity of multimedia information, where the association enables access to the selected portion of the quantity of multimedia information (see Exhibit 'D', p. 4, 5th paragraph, 2nd sentence); and storing the notation and the association for retrieval at a future time, where the future time is one of a time during the meeting and a time after the meeting, wherein a single action by the notetaking user initiates the steps of receiving the notation, recording, selecting, creating, and storing (see Exhibit 'D', p. 3, 5th paragraph, 3rd sentence and p. 3, 6th paragraph, 1st sentence).

CONCEPTION AND DUE DILIGENCE

In the event that the Examiner finds that the current declaration supports conception of the claimed limitations of the invention prior to the publication date of the Stifelman reference, but not actual reduction to practice, then diligence is required just prior to the effective date of the reference (March 31, 2001) until constructive reduction to practice (April 26, 2001) under 37 CFR 1.131. MPEP 715.07(a).

Applicant therefore addresses this eventuality through the declaration of Drs. Patrick Chiu, Donald G. Kimber, John Steven Boreczky and Andreas Girgensohn (hereafter Chiu et al. declaration). In the declaration, Drs. Chiu, Kimber, Boreczky and Girgensohn state that they are employees of Fuji Xerox Palo Alto Laboratories, and specialize in computer software development. (Chiu et al. declaration, ¶2). Drs. Chiu, Kimber, Boreczky and Girgensohn state that they are co-inventors of U.S. patent application 09/843,197. (Chiu et al. declaration, ¶3). The declaration and the official USPTO record establish diligence through the following acts:

(i) receiving from Jonathan M. Hollander hereafter 'JMH' (Fliesler Meyer LLP Attorney) a revised manuscript of the application on March 27, 2001 (Chiu et al. declaration, ¶32);

(ii) responding with comments to Jonathan M. Hollander regarding the revised manuscript on April 10, 2001 (Chiu et al. declaration, ¶33);

(iii) receiving a request from Jonathan M. Hollander for their full names and residential addresses, with the stated purpose of preparing a declaration by the inventors (Chiu et al. declaration, ¶34);

(iv) receiving a request from Jonathan M. Hollander regarding their employment status for assignment purposes on April 16, 2001 (Chiu et al. declaration, ¶36);

(v) signing the declaration and assignment between the dates of April 17, 2001 and April 23, 2001 (Chiu et al. declaration, ¶39);

(vi) mailing the signed declaration and assignment to Jonathan M. Hollander on April 23, 2001 (Chiu et al. declaration, ¶40);

(vi) the Examiner is requested to take official notice that the USPTO record of the application indicates that the application was filed on April 26, 2001; and

(vii) the Examiner is requested to take official notice that the USPTO record of the application indicates that the application was filed with a valid declaration and assignment signed by all inventors submitted as of the filing date.

As such the Applicants respectfully submit that they have established due diligence from before the publication date of Stifelman until constructive reduction to practice.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 4, 11-12 and 14-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stifelman, et al., "The Audio Notebook, Paper and Pen Interaction with Structured Speech," SIGCHI's 01, March 31-April 4, 2001, vol. 3, iss. 1, ACM 2001, pages 182-189 (hereafter, "Stifelman") in view of Arons el al., U.S. Pat No. 6,529,920 (hereafter, "Arons").

The Applicant relies upon the current declaration of Drs. Patrick Chiu, Donald G. Kimber, John Steven Boreczky and Andreas Girgensohn to establish prior actual reduction to practice. Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "Lite Minutes system" prototype consists of "LiteMinutes.java" and "DataStore.exe" and software modules as listed in Exhibits 'A'-'C' (Chiu et al. declaration, ¶6).

Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "Lite Minutes system" prototype embodiment of the invention contained all the elements of Claim 1 as described and claimed in the above U.S. patent application (Chiu et al. declaration, ¶7). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to receive a notation from a notetaker during a meeting as claimed in Claim 1, element (a) (Chiu et al. declaration, ¶8). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to automatically record an index value for the notation as claimed in Claim 1, element (b) (Chiu et al. declaration, ¶9). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to receive multimedia information from a multimedia source as claimed in Claim 1, element (c) (Chiu et al. declaration, ¶10). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to automatically select a portion of multimedia information as claimed in Claim 1, element (d) (Chiu et al. declaration, ¶11). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to automatically create an association between a notation and selected multimedia information as claimed in Claim 1, element (e) (Chiu et al. declaration, ¶12). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to store a notation and the association for retrieval at a future time as claimed in Claim 1, element (f) (Chiu et al. declaration, ¶13).

Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "Lite Minutes system" prototype embodiment of the invention contained all the elements of Claim 15 as described and claimed in the above U.S. patent application (Chiu et al. declaration, ¶15). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to receive a plurality of notations from a notetaking user as claimed in Claim 15, element (g) (Chiu et al. declaration, ¶16). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to record an index value for each of the plurality of notations, the index value based on the context of each notation as claimed in Claim 15, element (h) (Chiu et al. declaration, ¶17). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to receive a quantity of multimedia information from at least one multimedia source as claimed in Claim 15, element (j) (Chiu et al. declaration, ¶18). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to select at least one

portion of the quantity of the multimedia information based on the index value of each notation as claimed in Claim 15, element (k) (Chiu et al. declaration, ¶19). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to create an association between each of the plurality of notations and the selected portion of the quantity of multimedia information, where the association enables access to the selected portion of the quantity of multimedia information as claimed in Claim 15, element (l) (Chiu et al. declaration, ¶20). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to store the plurality of notations and the respective associations for retrieval at a future time, where the future time is a time during the meeting as claimed in Claim 15, element (m) (Chiu et al. declaration, ¶21). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to transmit the plurality of notations and their respective associations via an electronic network to at least one user as claimed in Claim 15, element (n) (Chiu et al. declaration, ¶22).

Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes.java" and "DataStore.exe" programs as shown in Exhibits 'A'-'C' were compiled prior to March 31, 2001 (Chiu et al. declaration, ¶23). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes.java" and "DataStore.exe" programs as shown in Exhibits 'A'-'C' were completed versions of a prototype of the invention described and claimed in the above U.S. patent application (Chiu et al. declaration, ¶24). Drs. Chiu, Kimber, Boreczky and Girgensohn state that a report commissioned on a prototype embodiment of the invention "Lite Minutes: An Internet-Based System for Multimedia Meeting Minutes" was signed by all inventors between March 10, 2000 and March 14, 2000 (Chiu et al. declaration, ¶29). A redacted version of this report is identified as Exhibit 'D'. This report contained embodiments of the invention with all limitations disclosed in Claims 1 and 15. As such, these co-inventors are able to establish actual reduction to practice of this invention prior to the effective date of the *Stifelman* reference. Therefore, the *Stifelman* reference is not available to be combined with *Arons*.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stifelman in view of Arons and further in view of Davis et al., "Notepals: Lightweight Note Sharing by the Group, for the Group," ACM 1999, pages 338-345 (hereafter, "Davis").

As discussed above, the Applicant has shown that *Stifelman* is neither anticipatory nor prior art to the Applicants invention and as such is not available to be combined with *Arons* and *Davis*.

Claims 10 and 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stifelman in view of Arons and Davis and further in view of Mora et al. (U.S. Pat No. 6,161,113).

As discussed above, the Applicant has shown that *Stifelman* is neither anticipatory nor prior art to the Applicants invention and as such is not available to be combined with *Arons*, *Davis* and *Mora*.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 103(a) rejections.

III. CONCLUSION

In light of the above, it is respectfully submitted that all remaining claims, as amended in the subject patent application, should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of the patent.

No fee is believed due in connection with this paper. However, the Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Dated: 4/28/06

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